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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,984	07/09/2001	Peter Gatis	11422-002001	6864

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BOSTON, MA 02110

EXAMINER
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ZHOU, TING

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/900,984

Applicant(s)

GATIS, PETER

Examiner

Ting Zhou

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 9 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The abstract is objected to as being too short in length; it is not adequately descriptive to convey the whole invention.

2. The disclosure is objected to because of the following informalities: the use of “display areas 114 to 120” on line 18 of page 13 misleadingly conveys the reference to display areas 114, 115, 116...120, instead of referring to display areas 114, 116, 118 and 120, as intended.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 31 recites the limitation "composite document comprised of separate documents" on lines 2-3 and claims 32-34 recite the limitation "conjoined subdocuments" on line 2 of the respective claims. The relationship between "conjoined subdocuments" and "composite document" is unclear.

4. Claims 34 recites the limitation "original subdocuments" on lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. U.S. Patent 6,009,442.

Referring to claims 1, 16 and 31, Chen et al. teach an apparatus for displaying a graphical user interface (GUI) and computer program stored on a computer-readable medium for viewing a composite document (clipped document as disclosed in column 4, lines 43-48 and shown in

Figures 2B and 3) comprised of separate documents having an ordered relationship, as recited in column 1, lines 64-67 and continuing onto column 2, lines 1-3. Specifically, Chen et al. teach a memory that stores executable instructions and a processor that executes the instructions (general purpose computer recited in column 3, lines 37-51) to generate an area for displaying the separate documents (document viewing utility) and a control for use in selecting the separate documents for display in accordance with the ordered relationship (document browsing utility), as recited in column 11, lines 25-30, column 14, lines 60-67 and column 15, lines 1-9. This can further be seen in Figures 10 and 12.

Referring to claims 2 and 17, Chen et al. teach a scroll bar for scrolling through the separate documents, as shown in Figure 12.

Referring to claims 3 and 18, Chen et al. teach a tree structure having the separate documents as selectable branches, as recited in column 5, lines 3-26 and shown in the left display panel of Figure 12.

Referring to claims 4 and 19, Chen et al. teach one or more buttons for scrolling through the separate documents (icons or thumbnails representing the separate documents), as recited in column 11, lines 43-57.

Referring to claims 5 and 20, Chen et al. teach the one or more tabs for selecting the separate documents, as shown in Figures 14 and 15.

Referring to claims 6 and 21, Chen et al. teach altering the ordered relationship (monitoring and updating the order as the result of the addition, deletion and modification of the documents) of the separate documents, as recited in column 6, lines 33-45.

Referring to claims 7 and 22, Chen et al. teach a drag bar for dragging and dropping the documents to a position relative to the other separate documents, as recited in column 16, lines 7-63.

Referring to claims 8 and 23, Chen et al. teach a notes section (annotations utility “177” shown in Figure 1B) for adding notations relating to at least one of the separate documents, as recited in column 18, lines 42-55.

Referring to claims 9 and 24, Chen et al. teach an options section (toolbar) for displaying one or more options that can be performed on the separate documents, as recited in column 12, lines 43-59. This can further be seen in Figure 12. This panel contains a display of icons on the toolbar displayed at the top of the figure representing actions that can be performed on the documents.

Referring to claims 10 and 25, Chen et al. teach the options section comprising an option to print one of the separate documents, as recited in column 11, lines 30-36 and evidenced by the print function icon shown in Figure 12.

Referring to claims 11 and 26, Chen et al. teach one of the separate documents heading a hierarchy of subdocuments and the GUI further comprising an area for displaying that hierarchy, as recited in column 11, lines 25-30. This can also be seen by the hierarchical tree structure in Figures 3 and 12.

Referring to claims 12 and 27, Chen et al. teach the subdocuments displayed to reflect their hierarchical relationship to the head of the hierarchy, as shown in Figure 12. For example, it is evident from viewing the display that “Medical” is a subset of “All Documents”, which is in turn a subset of “Indexed Categories”.

Referring to claims 13 and 28, Chen et al. teach an area for displaying identifying information (summary information contained in property sheets) for the separate documents, as recited in column 2, lines 7-16 and column 18, lines 56-67.

Referring to claims 14 and 29, Chen et al. teach the separate documents comprising of an image document and a text document, as recited in column 15, lines 33-36.

Referring to claims 15 and 30, Chen et al. teach options for editing the separate documents (manipulating the documents such as copying and moving and consolidating the documents), as recited in column 11, lines 30-37 and column 12, lines 10-12.

Referring to claim 32, Chen et al. teach an area for displaying conjoined subdocuments prior to printing, as shown in the right panels of Figures 12 and 13. As can be seen from the figures, previews of the documents are shown in the display region.

Referring to claim 33, Chen et al. teach displaying options for editing the conjoined subdocuments (clipped documents) prior to printing, as recited in column 11, lines 30-37, column 12, lines 10-12 and column 15, lines 18-26. The user has the option to copy, move, etc. the documents before choosing the print option.

Referring to claim 34, Chen et al. teach the edits made to the conjoined subdocuments reverting to the original subdocuments for further editing, display or storage, as recited in column 4, lines 63-67 and continuing onto column 5, lines 1-2. When subdocuments (clipped documents) are modified or edited, the system reverts to the original STG file associated with each document to store and update that information as well.

6. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach electronic books with similar mechanisms for note taking and retrieval.

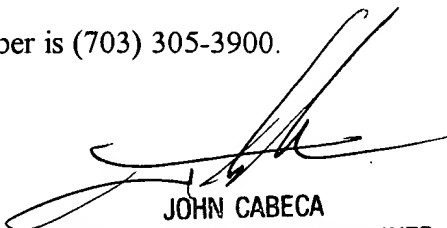
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703) 305-0328. The examiner can normally be reached on Monday - Friday 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

January 9, 2004

  
JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100